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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Bridon *et al.*

Confirmation No.: 7359

Serial No.: 10/722,733

Art Unit: 1648

Filed: November 25, 2003

Examiner: Zachariah Lucas

For: LONG LASTING SYNTHETIC GLUCAGON
LIKE PEPTIDE (GLP-1)

Attorney Docket No.: 11767-055-999
(CAM: 515319-999055)

PETITION UNDER 37 C.F.R. § 1.182

Mail Stop Petition

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants, through their attorneys, hereby petition, pursuant to Rule 182, to amend the above-identified abandoned application (hereinafter “the ’733 application”) to recite the correct relationship, pursuant to 37 C.F.R. § 1.78 (a)(2)(i), to a prior co-pending application to which priority is claimed pursuant to 35 U.S.C. § 120. In particular, Applicants seek to amend the ’733 application to recite that the ’733 application is a continuation-in-part of the prior filed, then co-pending, non-provisional application, U.S. Patent Application no. 09/623,548 (hereinafter “the ’548 application”).

REMARKS

The filing receipt of the ’733 application, dated March 15, 2004, and submitted herewith as Exhibit 1, indicates that the domestic priority data for the ’733 application, as claimed by Applicants, are the following (emphasis added):

This application is a CON of 10/288,340 11/04/2002
which is a DIV of 09/657,332 09/07/2000 PAT 6,514,500
which claims benefit of 60/159,783 10/15/1999
This application 10/722,733
is a CON of 09/623,548 09/05/2000
which is a 371 of PCT/US00/13576 05/17/2000
which claims benefit of 60/159,783 10/15/1999
and claims benefit of 60/153,406 9/10/1999
and claims benefit of 60/134,406 05/17/1999.

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Thus, the filing receipt states that the '733 application is a continuation of the '548 application.

In addition, the Application Data Sheet filed in the United States Patent and Trademark Office ("USPTO") on November 25, 2003 concurrently with the '733 application, submitted herewith as Exhibit 2, indicates that the '733 application "[c]laims priority to" the '548 application (*see* Exhibit 2, page 5). Furthermore, a Preliminary Amendment filed in the USPTO on November 25, 2003 in connection with the '733 application, submitted herewith as Exhibit 3, amended the specification to reference the priority applications, which amendment recited in relevant part:

This application also claims priority to U.S. Application No. 09/623,548, filed September 5, 2000 which is a § 371 of PCT/US00/13576, filed May 17, 2000 and claims benefit of earlier filed U.S. Provisional Application Nos. 60/159,783, filed October 15, 1999, 60/153,406, filed September 10, 1999, and 60/134,406, filed May 17, 1999. The contents of all the above cited patents and patent applications are ~~which is~~ hereby incorporated by reference in its their entirety.

Thus, the priority claim to the '548 application, as provided in the Application Data Sheet and Preliminary Amendment filed on November 25, 2003, failed to indicate the relationship between the '733 application and the '548 application, while the Filing Receipt for the '733 application indicates that the '733 application is a continuation of the '548 application. However, Attorneys for Applicants have realized that the correct relationship of the '733 application to the '548 application is as a continuation-in-part. Thus, Applicants hereby petition under 37 C.F.R § 1.182 to amend the abandoned '733 application to reflect the correct relationship to the '548 application. Specifically, Applicants respectfully request that the '733 application be amended to reflect that the '733 application is a continuation-in-part of the '548 application.

A Supplemental Application Data Sheet for the '733 application, showing the correct relationship of the '733 application to the '548 application, as well as updated attorney information and docket number, is submitted herewith. Pursuant to 37 C.F.R. § 1.76 (d)(1), the updated information in this Supplemental Application Data Sheet will govern, notwithstanding any inconsistent information in the prior filed amendment to the specification. Applicants respectfully request entry of the Supplemental Application Data Sheet into the file history of the '733 application.

Applicants respectfully submit that amendment of an abandoned application to correct a priority claim is proper under 35 U.S.C. § 120. In *Sampson v. Commissioner of Patents and Trademarks*, 195 U.S.P.Q. 136 (D.D.C. 1976), the court held that an Applicant who failed to indicate the filing dates of prior applications relied upon for priority pursuant to 35 U.S.C. § 120 during the pendency of an application may be allowed to amend the application after abandonment to perfect the priority claim. The court stated:

[H]ere the omissions occurred in prior intermediate applications which had become abandoned. Plaintiff therefore filed amendments to the abandoned, intermediate applications to insert what he believed to be technical information, *i.e.*, the filing dates of the applications relied upon in his application chain.

...

.... A reading of § 120 makes it clear that an amendment may be entered in an abandoned application for purposes other than prosecution.

Id. at 137 (citation omitted). Since Applicants hereby seek to provide technical information, *i.e.* the correct relationship between the '733 application and the '548 application, in an abandoned application to perfect the priority claim in a manner analogous to the Applicant in *Sampson*, Applicants for the '733 application respectfully submit that the amendment of the '733 application as requested above is proper.

Additionally, Applicants submit that amendment of an abandoned application to correct a priority claim under 35 U.S.C. § 120 is properly petitionable under 37 C.F.R. § 1.182. In a telephone discussion of September 5, 2007 between Mr. Mark Polutta, Senior Legal Advisor, Office of Patent Legal Administration, USPTO, and Mr. Wayne Szeto, an Attorney for Applicants, Attorneys for Applicants were advised that a request to amend an abandoned application, including requests to amend a priority claim in an abandoned application, should proceed by way of petition under 37 C.F.R. § 1.182. Accordingly, Applicants are submitting the instant petition to correct the priority claim under 35 U.S.C. § 120.

In view of the foregoing, Applicants respectfully request that the '733 application be amended to indicate that the '733 application is a continuation-in-part of U.S. Application No. 09/623,548.

Pursuant to 37 C.F.R. § 1.17(h), it is estimated that the fee for filing this petition is \$130.00. Please charge the required fee and any other fees that may be due to Jones Day Deposit Account No. 50-3013. A copy of this sheet is enclosed. If there are any questions concerning this Petition, please contact the undersigned attorney.

A Revocation and Power of Attorney is submitted herewith making the undersigned of record before the USPTO in connection with the above-identified application.

Respectfully submitted,

Date: June 30, 2008



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For: Adriane M. Antler (Reg. No. 32,605) (Reg. No.)


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